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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,200	10/28/2003	Shu Chen Chang	4132SF	2224

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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,200

Applicant(s)

CHANG, SHU CHEN

Examiner

Gregory Pickett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/28/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 2 recites, "at least one bar", the disclosure is not enabling for more than two retaining bars. The examiner questions how 3, 5, or 7 or more retaining bars would be accommodated.

Further, claim 4 recites, "at least one link", the disclosure is not enabling for a single link, nor more than two links. The examiner questions the stability of the structure with a single link and also questions how 7 or more links would be arranged.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 16-18 recite the limitation "said blocks" in line 1. There is insufficient antecedent basis for this limitation in the claims. To prosecute the claims on their merits, the examiner assumes claims 16-18 depend from claim 15.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 8, 12, 13, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasudeva (US 5,918,741).

Regarding claim 1, Vasudeva discloses a plate **1** with a plurality of cavities **10**, a plurality of tool elements **12**, and a means **2** for retaining the tool elements.

As to claim 2, Vasudeva discloses means **2** as a bar for retaining tool elements **12** within cavities **10**.

As to claim 3, Vasudeva discloses apertures (portion of **7** on bar **2**).

As to claim 8, Vasudeva discloses retaining device **5**.

As to claim 12, Vasudeva discloses retaining fingers **18**.

As to claim 13, Vasudeva discloses seat (portion of **7** on plate **1**).

As to claim 19, Vasudeva discloses a bulge (portion of plate **1** from which seat **7** is cut).

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4. Claims 1, 2, 4, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tzu-Ching (US 5,484,057).

Regarding claim 1, Tzu-Ching discloses a plate **1** having cavities **30**, a plurality of tool elements **100**, and a means **5** for retaining the tool elements **100** within cavities **30**.

As to claim 2, means **5** is a bar.

As to claim 4, Tzu-Ching discloses plural means **5** for retaining (see Figure 3).

As to claim 15, Tzu-Ching discloses blocks **3**.

As to claim 16, Tzu-Ching discloses blocks **3** as one piece.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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5. Claims 1, 2, 4, and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (US 6,644,474) in view of Kao (US 5,975,297).

Regarding claim 1, Lai discloses (see Figure 1) a plate **10** with cavities **11**, a plurality of tool elements **12**, and a means **20** for retaining the tool elements within cavities **11**. Lai lacks, or does not expressly disclose the retention of a tool member.

Kao '297 discloses the provision of a tool member **50** in the same display pack as the tool elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the plate of Lai with a means for retaining a tool member as taught by Kao '297 in order to retain both the tool member and tool elements within the same display pack.

As to claim 2, means **20** of Lai is a bar.

As to claim 4, Lai discloses 2 bars **20**.

As to claim 8, Lai-Kao discloses a retaining device (Kao **15**).

As to claim 9, Lai-Kao discloses a retaining device with a clip (Kao **15**) and two catches (Kao **151**).

As to claim 10, Lai-Kao discloses two catches (Kao **151**) with enlarged heads (Kao **152**).

As to claim 11, Lai-Kao discloses opening (Kao **16**).

As to claim 12, Lai-Kao discloses retaining fingers (Kao **14**).

As to claim 13, Lai-Kao discloses seat (Kao **161**).

As to claim 14, Lai-Kao discloses seat (Kao **161**) that is curved, the inner part of which is a recess.

6. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai-Kao as applied to claims 2 and 4 above, and further in view of Kao (US 6,669,032).

Lai-Kao discloses the claimed invention except for the apertures on the retaining bar.

Kao '032 discloses a display pack (Figure 1) with apertures **22** in the retaining bar **20**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the pack of Lai-Kao with apertures as taught by Kao '032 in order to accommodate tool elements of odd shape (as seen in Figure 2 of Kao '032).

7. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tzu-Ching (US 5,484,057).

Tzu-Ching discloses the claimed invention except for the blocks extending upwardly or downwardly beyond the plate.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to extend the blocks upwardly or downwardly beyond the plate, because applicant has not disclosed that such extensions provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with blocks even with the plate or extending upwardly or downwardly beyond the plate because the tool elements would have been retained in the same manner.

Therefore, it would have been an obvious matter of design choice to modify Tzu-Ching to obtain the invention as specified in claims 17 and 18.

Allowable Subject Matter

8. Claims 5 and 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

7A

Greg Pickett
Examiner
29 October 2004



Mickey Yu
Supervisory Patent Examiner
Group 3700